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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,797	07/26/2002	Achim Gopferich	02592	1932
KENTON R. MULLINS STOUT, UXA, BUYAN & MULLINS, LLP 4 VENTURE SUITE 300 IRVINE, CA 92618				
EXAMINER				
SILVERMAN, ERIC E				
ART UNIT		PAPER NUMBER		
1618				
MAIL DATE		DELIVERY MODE		
06/05/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/019,797

Applicant(s)

GOPFERICH ET AL.

Examiner

ERIC E. SILVERMAN

Art Unit

1618

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3, 9-15, 33, 36-38 and 41-44.
Claim(s) withdrawn from consideration: 16-32 and 60-66.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s) _____.
13. ☐ Other: _____.

/Eric E Silverman/
Examiner, Art Unit 1618

Continuation of 3. NOTE: The term "a block copolymer comprising a population of molecules joined to a surface," which the proposed amendment would add to various claims, raises issues under 112 second para. A block copolymer is a single molecule - it is not clear how a single molecule can comprise a collection of molecules.

Continuation of 11. Applicants first argue that the PEG-PLA of the '890 patent does not sufficiently describe PEG-PLA to comply with the requirements of 112 first paragraph. In response, PEG-PLA is a well known term of art, referring to aa AB block copolymer of polyethylene glycol and poly lactic acid. Further description is not required. The relative molecular weights of the PEG and PLA, and the total molecular weight of the polymer are not germane because the claims at issue do not require any particular molecular weight or stoichiometry. Applicants reliance on the Milburn opinion is confusing, as that opinion was issued before the Patent Act of 1952, and dealt with different statutes than those at issue here. Also, Milburn dealt with the validity of an issued patent, not patentability of an application for a patent. Issued patents enjoy a presumption of validity that applications for a patent do not enjoy. See Exxon Research & Eng'g Co. v. Unites States, 265 F3d 1371, 1371 (Fed. Cir. 2001) (refusing to find a claim indefinite unless reasonable efforts and claim construction were futile in order to "accord respect to the statutory presumption of patent validity.") The applicability of Milburn to the case at issue here is, at best, questionable. Further, because an issued patent has a presumption of validity, this Office does not have the legal competency to declare that an issued patent does not comply with 35 U.S.C. 112 first paragraph. Regardless of the above, Applicants arguments merely speculate that the well known term PEG-PLA is indefinite. Contrary to Applicants assertion, this term is well known in the art, requiring no additional explanation. A reference is presumed to be operable until Applicant provides facts rebutting the presumption of operability. MPEP 2121.02 (citing In re Sasse, 207 USPQ 107 (CCPA 1980)). Applicants have failed to provide any such facts in this case.